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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/864,084  | 05/22/2001  | Phillip Andrew Seder | P0377               | 1802             |
| 23735   | 7590        | 12/21/2004           | EXAMINER            |                  |
| DIGIMARC CORPORATION<br>9405 SW GEMINI DRIVE<br>BEAVERTON, OR 97008 |             |                      | LEMMA, SAMSON B     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2132                |                  |
| DATE MAILED: 12/21/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/864,084 | <b>Applicant(s)</b><br>SEDER ET AL. |  |
|                              | <b>Examiner</b><br>Samson B Lemma    | <b>Art Unit</b><br>2132             |  |

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## ***DETAILED ACTION***

1. **Claims 1-38** have been examined.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 1-11; 13-14; 16-18; 20-32; 34-38** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of the copending Application No. 09/853835 (hereinafter referred to as '835 application). Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

- **As per claim 1** of the instant application, claim 1 of the '835 application recite similar method of regulating access to a website by a user terminal via the internet, except claim '835 further recites storing the response information and at the central computer, verifying authority to access the website based at least in part on a comparison of the verification information and the stored response

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information. Furthermore all elements/limitation of claim 1 of the instant application is recited in the claim 1 of the '835 application.

- **As per claims 10 and 20** of the instant application, claim 14 of the '835 application recite similar method of authenticating permission to access to a system, except claim '835 further recites querying a data structure to determine whether the verification key is authorized. Furthermore all elements/limitation of claims 10 and 20 of the instant application is recited in the claim 1 of the '835 application.

- **As per claim 24, 31 and 38** of the instant application, and claims 22 and 26 of the '835 application recite similar method of exchanging data except claims 24, 31 and 38 of the instant application instead of generating a number at the central server and storing the number and extracted watermark identifier in the database as response information, It recites generating a validation key and encode the validation key and communicate it to the user terminal. All the rest of the elements/limitation of claims 10 and 20 of the instant application is recited in the claim 22 of the '835 application.

In further regards

- **Claims 2 and 16** of the instant application and claim 2 of the '835 application further recites similar limitation of identifying data comprising a document identifier.
- **Claims 3, 23, 25 and 32** of the instant application recites similar limitation of claim 3 of the '835 application.
- **Claims 4, 9, 21, 26 30 and 34** of the instant application recites similar limitation of claims 4-7 and 13,17-18 and 31 of the '835 application.

- **Claims 5-8,27-29 and 36** of the instant application recites similar limitation of claim 12 of the '835 application.
- **Claims 11** of the instant application recites similar limitation of claim 1 of the '835 application.
- **Claims 13-14** of the instant application recites similar limitation of claims 7-8 and 11 of the '835 application.
- **Claims 17-18** of the instant application recites similar limitation of claims 8 and 10 of the '835 application.
- **Claims 22** of the instant application recites similar limitation of claim 14 of the '835 application.
- **Claims 35 and 37** of the instant application recites similar limitation of claim 20 of the '835 application.

### ***Specification***

4. The disclosure is objected because of the following informalities:
  - On page 16, starting from the last line up to page 17 first Paragraph, the following has been mentioned. "If the validation key is stored in the database (or has been received within a predetermined period), access to the website is denied (step S84). Otherwise access to the website is allowed (S86) ". It should have been written as "If the validation key is not stored in the database (or has not been received within a predetermined period), access to the website is denied (step S84). Otherwise access to the website is allowed (S86) ".

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Appropriate correction is required.

### ***Drawings***

5. The drawing is objected because of the following informalities:

- On page 9, reference [0039], "connection 24 " has been mentioned with respect to figure 1, however there is no reference on the corresponding figure 1 which indicate "connection 24".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-38** are rejected under 35 U.S.C. 102(e) as being anticipated by

**Philyaw** (hereinafter referred to as **Philyaw**) (U.S. Patent No. 6,631,404).

8. **As per claim 1 Philyaw** discloses a method for a method of regulating access to a website by a user terminal via the internet, (Figure16 and figure 25)

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- The user terminal reading a document including an embedded digital watermark, (column 27, lines 18-23) said method comprising the steps of:

- At the user terminal, extracting identifying data from the digital watermark, (column 26, lines 58-column 27, line 2; column 27, lines 18-23) and

- Providing the identifying data to a central computer; (Column 28, lines 11-23; figure 25, ref. Num "2510") (Central computer is met, reference computer "2510" which is shown on figure 25, ref. Num "2510")

At the central computer:

- Identifying a pointer associated with the identifying data; (Column 28, lines 35-39; column 28, lines 39-63)
- Generating a validation key; and providing the pointer and the validation key to the user terminal; (Column 28, lines 64-67; column 29, lines 1-18)

At the user terminal,

- Communicating with the website via the pointer and providing the validation key to the website; (Column 30, lines 14-30; figure 25, ref. Num "2516") (website is met, target location "2516") and

At the website,

- Regulating access to the website by the user terminal based at least in part on the validation key.(Column 30, lines 66- column 31, line 5)

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9. **As per claim 10 and 20 Philyaw** discloses a method of authenticating permission to access a system comprising the step of:

- Receiving a request to enter the system, the request including at least a validation key; (Column 30, lines 66-column 31, lines 5; Column 31, lines 5-39)
- Determining whether the validation key is valid; and allowing access to the system based on a determination of said determining step. (Column 30, lines 66-column 31, lines 5; Column 31, lines 5-39)

10. **As per claim 24, 31 and 38 Philyaw** discloses a system for exchanging data comprising:

- A central server comprising at least one database including pointer information, (Figure 25, ref. Num “2510”; figure 25, ref. Num “2512”; ) ( Central computer or central server is met the “reference computer” shown on figure 25, ref. Num “2510” and the database is met the database or “DB” shown on figure 25, ref. Num “2512”) wherein
- When a user terminal communicates an extracted watermark identifier to said central server, said central server identifies a corresponding pointer associated with the extracted watermark identifier, (Column 28, lines 35-39; column 28, lines 39-63; column 27, lines 18-23; column 28, lines 11-23; figure 25, ref. Num “2510”) and wherein



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- Said central server generates a validation key and encodes the validation key, and wherein said central server appends the validation key to the corresponding pointer, and communicates the pointer and validation key to the user terminal. (Column 30, lines 8-19; column 32, lines 66-column 33, line 5)

11. **As per claim 2 and 16** Philyaw discloses the method as applied to claims 1 and 10 above. Furthermore **Philyaw** discloses the method wherein the identifying data comprises a document identifier. (column 27, lines 18-23; column 25, lines 19-29)

12. **As per claims 3, 25 and 32-33**, **Philyaw** discloses the method as applied to claims 2, 24 and claim 31 above. Furthermore **Philyaw** discloses the method wherein the pointer comprises at least one of a URL, IP address and web address. (Column 28, lines 59-63; column 32, lines 65-67)

13. **As per claims 4, 11 and 26**, **Philyaw** discloses the method as applied to claims 2, 10 and 25 above. Furthermore **Philyaw** discloses the method wherein the validation key comprises a date-time value. (Column 30, lines 55-61)

14. **As per claims 5-8 and 27-29**, **Philyaw** discloses the method as applied to claims 2 and 24 above. Furthermore Philyaw discloses the method further comprising the step of encoding the validation key wherein the encoding comprises at least one of hashing, encrypting, and rotating. (Column 30, lines 10-14)

15. **As per claims 9, 21, 30 and 34**, **Philyaw** discloses the method as applied to claims 1, 20, 24 and 32 above. Furthermore **Philyaw** discloses the method

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wherein the validation key comprises at least one of a time stamp, a predetermined number, and a pseudo-random number.(Column 30, lines 55-61)

16. **As per claim 12**, **Philyaw** discloses the method as applied to claim 10 above.

Furthermore **Philyaw** discloses the method further comprising the step of decoding the validation key. (column 30, lines 17-19)

17. **As per claims 13-15**, **Philyaw** discloses the method as applied to claim 10 above. Furthermore **Philyaw** discloses the method wherein the validation key comprises a timestamp, and said determining step determines whether the timestamp is stale. (column 30, lines 55-61;column 33, lines 1-16)

18. **As per claims 17-18**, **Philyaw** discloses the method as applied to claim 10 above. Furthermore **Philyaw** discloses the method further comprising a step of determining whether the validation key comprises a valid value.(Column 33, lines 1-15)

19. **As per claims 19 and 23**, **Philyaw** discloses the method as applied to claim 10 and claim 21 above. Furthermore **Philyaw** discloses the method wherein the request includes a URL and the validation key is appended to the URL. (Column 32, lines 66-column 33, line 5).

20. **As per claim 22**, **Philyaw** discloses the method as applied to claim 21 above. Furthermore **Philyaw** discloses the method wherein said determining step comprises the steps of querying a database to determine if the validation key is stored therein.(column 29, line 58- column 30, line 5)

21. **As per claims 35 and 37**, **Philyaw** discloses the method as applied to claim 34 above. Furthermore **Philyaw** discloses the method wherein said document identifier comprises an identifier extracted from a digitally watermarked document. (column 27, lines 18-23; column 25, lines 19-29)

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22. **As per claims 36**, **Philyaw** discloses the method as applied to claim 35 above.

Furthermore **Philyaw** discloses the method further comprising the step of encoding the validation key (Column 30, lines 10-14)

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

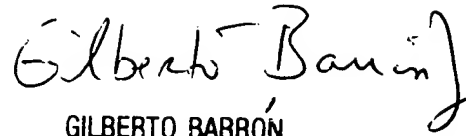
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SAMSON LEMMA

S.L

12/08/2004

A handwritten signature in black ink, reading "Gilberto Barrón". The signature is written in a cursive style with a large, stylized "G" and "B".

GILBERTO BARRÓN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100